

REMARKS

In the Office Action dated September 1, 2005, claims 1, 3-8, 10, 12-16 and 18-23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. US 6,285,398 ("Shinsky et al.") in view of U.S. Patent Application No. US 2004/0169767 A1 ("Norita et al."). In response, Applicant respectfully asserts that the Office Action has failed to establish a *prima facie* case of obviousness, as explained below. In particular, the Office Action has failed to point out a valid suggestion or motivation to combine the teachings of Shinsky et al. and Norita et al. to derive the claimed invention, as recited in the independent claims 1, 10 and 18. As such, Applicant respectfully requests the allowance of the pending claims 1, 3-8, 10, 12-16 and 18-23.

A. Patentability of Independent Claims 1, 10 and 18

The Office Action has rejected the independent claims 1, 10 and 18 under 35 U.S.C. §103(a) as allegedly being unpatentable over Shinsky et al. in view of Norita et al. However, the Office Action has failed to establish a *prima facie* case of obviousness for these claims 1, 10 and 18. As such, Applicant respectfully requests that the independent claims 1, 10 and 18 be allowed.

The cited reference of Shinsky et al. discloses a CCD video camera that is coupled to a host computer. As described in column 4, lines 6-26, of Shinsky et al., the CCD video camera does not include a DSP circuit, and thus, raw video data representing frames of captured images is transmitted from the CCD video camera to the host computer. At the host computer, the raw video data is processed and converted into the appropriate video format for display, storage and/or transmission. Through a graphic user interface, a user has the ability to view the video images being captured by the camera, set a proper white balance by selecting a white area within the picture and view a histogram.

The cited reference of Norita et al. discloses a digital camera that can sequentially capture a plurality of image signals corresponding to a plurality of exposure times with respect to a substantially same scene. As described in paragraphs

[0019] and [0020] of Norita et al., captured images corresponding to a plurality of predetermined exposure times are sequentially displayed with increased exposure by a predetermined time interval.

The Office Action correctly states on page 4 that Shinsky et al. "fails to distinctly state that first and second images having different image capturing parameters are displayed for user selection and the current settings of the image capturing parameters are adjusted to conform with one of the first and second images selected by a user." However, the Office Action then alleges that Norita et al. "discloses a method of displaying comparison images for user selection and subsequently adjusting settings of an image capturing device according to the user selection." Furthermore, the Office Action asserts that "it would have been obvious for one skilled in the art to have been motivated to include the concept of adjusting the [current] settings of image capturing parameters according to a displayed image that is selected by a user as disclosed by Norita in the method of processing raw image data by setting image capturing parameters using a graphical user interface as disclosed by Shinsky." The alleged motivation for this modification is that "[d]oing so would provide a means for specifying an image having proper image capturing parameters while viewing a serially updated image in order to set the image capturing parameters (Norita: page 7, paragraph 135)."

The problem with the alleged motivation, as asserted by the Examiner, is that the cited reference of Norita et al. does not support such a motivation to combine the teachings of Shinsky et al. and Norita et al. The cited reference of Norita et al. on page 7, paragraph 135, states:

"The above construction and operation of the digital camera 100A enables a user to specify an image to be recorded while viewing a serially-updated exposure condition on the display as in the first preferred embodiment. Accordingly a proper image can be selected and recorded. This mode is suitable for photo shooting requiring a long exposure time, e.g., for capturing a night view or celestial objects."

The focus of this cited passage of Norita et al., and most of Norita et al., is the ability to capture a plurality of image signals corresponding to a plurality of exposure times so that a proper image can be selected and recorded. However, Shinsky et al. discloses a CCD video camera that is coupled to a host computer, and the manner

with which raw video data captured by the video camera is processed. Since the focus of Shinsky et al. is a CCD video camera and the captured video data, Shinsky et al. is not concerned with exposure times. In fact, the statement in Norita et al. on page 7, paragraph 135, that “[t]his mode is suitable for photo shooting requiring a long exposure time, e.g., for capturing a night view or celestial objects” does not make sense in the context of video camera and video data. Therefore, one of ordinary skill in the art would not have been motivated to combine the teachings of Shinsky et al. and Norita et al. since the focus of Shinsky et al. is capturing and processing video images and the focus of Norita et al. is capturing and processing still images with different exposure times.

Furthermore, there is no suggestion or motivation found in either reference that displaying different images for user selection should be applied to any image capturing parameters other than exposure time, as described in Norita et al. Only by using impermissible hindsight could one suggest applying the teachings of Norita et al. to other image capturing parameters. As such, Applicant respectfully asserts that the independent claims 1, 10 and 18 are not rendered obvious in view of Shinsky et al. and Norita et al., and requests that these claims be allowed.

B. Patentability of Dependent Claims 3-8, 12-16 and 19-23

Each of the dependent claims 3-8, 12-16 and 19-23 depends on one of the independent claims 1, 10 and 18. As such, these dependent claims include all the limitations of their respective base claims. Therefore, Applicant submits that these dependent claims are allowable for at least the same reasons as their respective base claims.

Applicant respectfully requests reconsideration of the claims in view of the claim amendments and the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,
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